

REMARKS

The application was filed on 19 April 2001 with sixteen claims. The Examiner examined the application and on 21 October 2004 issued a first Action. In the Examiner's Action, the Examiner rejected claims 1-7 and 10-16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,405,364 B1 entitled BUILDING TECHNIQUES IN A DEVELOPMENT ARCHITECTURE FRAMEWORK to Bowman-Amuah (Bowman-Amuah '364). The Examiner also rejected claims 8-9 under 35 U.S.C. §103(a) as being unpatentable over Bowman-Amuah '364 in view of U.S. Patent No. 5,519,778 entitled METHOD FOR ENABLING USERS OF A CRYPTOSYSTEM TO GENERATE AND USE A PRIVATE PAIR KEY FOR ENCIPHERING COMMUNICATIONS BETWEEN THE USERS to Leighton et al. (Leighton '778). In response, Applicants amended the specification and claims. The Examiner then finally rejected claims 1-7 and 10-16 under 35 U.S.C. §103(a) as being unpatentable over Bowman-Amuah '364 in view of U.S. Patent No. 4,672,572 entitled PROTECTOR SYSTEM FOR COMPUTER ACCESS AND USE to Alsberg (Alsberg '572); and finally rejected claims 8 and 9 under 35 U.S.C. §103(a) over Bowman-Amuah '364, Alsberg '572, and Leighton '778. Applicants attempted to put the claims in condition for allowance and/or better condition for appeal by amendment. The Examiner did not enter the amendments. Applicants, believing that patentable subject matter exists, filed a Request for Continued Examination.

The Examiner then entered the amendments and rejected claims 1-7 and 10-16 under 35 U.S.C. §103(a) over Bowman-Amuah '364, Alsberg '572 and U.S. Patent No. 6,671,809B1 entitled SOFTWARE-DEFINED COMMUNICATIONS SYSTEM EXECUTION CONTROL to Perona et al. (Perona '809). The Examiner further maintained the same rejection of claims 8-9 under 35 U.S.C. §103(a) over Bowman-Amuah '364, Alsberg '572, and Leighton '778. Applicants amended the claims. The Examiner then issued a final rejection of the claims rejecting claim 7 under 35 U.S.C. §101, and claims 1-7 and 10-16 under 35 U.S.C. §103(a) over Bowman-Amuah '364 in view of Alsberg '572 and Perona '809. The Examiner maintained the rejection of claims 8-9 under 35 U.S.C. §103(a) over Bowman-Amuah '364, Alsberg '572, and Leighton '778. In response to the Examiner's final rejection of the claims, Applicants traversed the rejections.

The Examiner then mailed an Office Action on 20 October 2006 wherein she maintained the rejection of claim 7 under 35 U.S.C. §§101, 103(a) and 112, second paragraph and claims 10-16 under 35 U.S.C. §103(a) over Bowman-Amuah '364 in view of Alsberg '572. The Examiner allowed claims 1-6. Claims 1-16 are pending.

Applicants amend claims 7 - 16, and add new claims 17-19. Claim 7 was amended editorially to overcome the rejection under 35 U.S.C. §112, second paragraph. In further amending claim 7 and amending other claims, Applicants have not added new matter. Support in the originally filed specification for claim 7 is given on page 10, line 20 through page 11, line 24. Support for the amendments to claim 8 is given in Figure 2 and also on page 12, line 1 through page 13, line 2. Support for the amendments to claims 9 and 10 are given in Figure 4 and on page 13, line 17 through page 14, line 3. Support for the amendments to claim 11 is given in Figure 5 and on page 15, line 4 -20. Support for the amendments to claim 16 and new claims 17-19 are given in Figure 7 and on page 15, line 19 through page 16, line 11. Support for claim 20 is given in U.S. Patent No. 6,950,802 B1 which was incorporated by reference on page 2, lines 5-7, and page 11, lines 1-2, 13-14, 16 and 22.

The Rejection of Claims 1-7 and 10-16 under 35 U.S.C. §103(a) over Bowman-Amuah '364, Alsberg '572, Perona '809, and Leighton '778

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, (Fed. Cir. 1991).

The Examiner rejected claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over a combination of Bowman-Amuah '364, Alsberg '572, Perona '809, and Leighton '778 (claims 8 and 9). Applicants traverse the rejection of the independent claim 7 upon which the other claims are dependent based on the alleged combination of Bowman-Amuah '364, Alsberg '572, Perona '809. Applicants also maintain the arguments presented in the response dated 25 September 2006 and further emphasize that neither Bowman-Amuah '364 nor Alsberg '572 nor Perona '809 nor

Leighton '778 provide a method to design an information technology system with a computer-implemented design tool having a security reference model comprising a plurality of interconnected and interdependent security subsystems that manage audits, integrity, and information flow control. Because none of the references disclose the claimed subject matter, their combination cannot do so either. Applicants respectfully request the Examiner to withdraw the rejection of claims 7-16 under 35 U.S.C. §103(a) over Bowman-Amuah '364, Alsberg '572, Perona '809, and Leighton '778.

The Rejection of claim 7 under 35 U.S.C. §101

The Examiner rejected claim 7 under 35 U.S.C. §101 saying the method of designing security, i.e., the collection of information does not fall within the statutory classes of 35 U.S.C. §101. Applicants traverse and maintain the arguments in the response dated 25 September 2006. In the spirit of allowing a long-pending patent application, Applicants have amended the claim 7 to be a computer-implemented method wherein the step of documenting the solution environment and security assumptions are accomplished using a computer-implemented design tool. Thus, the method steps do occur in a tangible computer processing environment and the solution environment is rendered on a computer-implemented design tool. Applicants respectfully request that the Examiner withdraw the rejection of claim 7 under 35 U.S.C. §101.

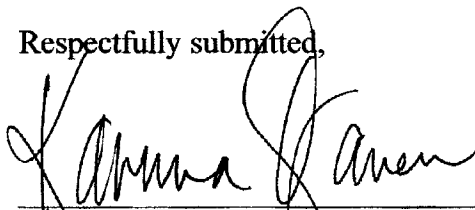
Conclusion

In order to establish a prima facie case of obviousness, the proper inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. The motivation for the combination must come from some objective basis, other than the Examiner's hindsight garnered from references. The references, moreover, must be combinable, that is the teachings in alleged combination must not destroy the principles of the references. Applicants maintain that the Examiner fails to present a prima facie case of obviousness because first, the references themselves do not suggest or teach their alleged combination. Second, there is no reasonable expectation of success of the combination because both Bowman-Amuah '364 and Alsberg '572 teach that audit security should be done independently and/or remotely, not with an audit subsystem that is interdependent and interconnected with other security subsystems. Third, the alleged combinations do not teach all

the claim limitations: Bowman-Amuah '364 does not teach the interconnectedness and interdependence of at least three security subsystems to define the functions and the properties of the entire system. Importantly, Alsberg '572 teaches that security functions are best handled by an external security server, so the Alsberg '572 reference cannot be properly combined with any reference that teaches the design of inherent and integrated security. Perona '809 does not teach the interconnectedness and interdependence of the security subsystems in determining the properties and functions of an IT system. Leighton '778 does not suggest ranking a solution environment using one or computer-implemented design tools, as claimed by Applicants.

Attorney for Applicants thank the Examiner for her review of these remarks. Attorney for Applicants further invite the Examiner invited to telephone the Attorney listed below if she thinks it would expedite issuance of the patent.

Respectfully submitted,



Karuna Ojanen
Registration No. 32,484
(507) 269-6622 voice

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OLO - Ojanen Law Offices
2665 Riverside Lane, NE
Rochester, MN 55906-3456

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